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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,103	08/26/2003	Frank J. Papa	133021-0031	6425
24267	7590	03/10/2005	EXAMINER	
CESARI AND MCKENNA, LLP			EVANISKO, LESLIE J	
88 BLACK FALCON AVENUE			ART UNIT	
BOSTON, MA 02210			PAPER NUMBER	
			2854	

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/650,103	<b>Applicant(s)</b> PAPA ET AL.	
	<b>Examiner</b> Leslie J. Evanisko	<b>Art Unit</b> 2854	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08/26/03 & 01/24/05.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 11-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 5, 7-10 and 14-22 is/are rejected.
- 7) ☒ Claim(s) 2, 3 and 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>09-26-2003 &amp; 03-15</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group I, claims 1-10 and 14-22 in the reply filed on January 24, 2005 is acknowledged.
2. Claims 11-13 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on January 24, 2005.

### ***Specification***

3. The disclosure is objected to because of the following informalities: The reference to attorney docket no. 133021-0032 in line 5 of page 1 should be amended to refer to the appropriate U.S. Application Serial No. On page 6, line 22, the term "232" should be --242-- since that is how the jig assembly was previously defined in line 22 and is shown in the drawings.

Appropriate correction and/or clarification is required.

### ***Claim Objections***

4. Claims 16, 18, and 20-21 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the

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claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. In particular, it is noted that claim 14 is drawn to a printing machine per se and does not include the business accessory as part of the claimed combination. Therefore, the claims reciting only further details of the business accessory or substrate on the accessory such as in claims 16, 18, and 20 fail to further limit the structure of the printing machine and are thereby improper dependent claims.

5. Claims 9 and 14-22 are objected to because of the following informalities:

With respect to claim 9, line 2, it is suggested that the term “of” be inserted after “production” as it appears it was inadvertently omitted by applicant. Additionally, in line 3 of claim 9, it is suggested that the term “the customer” be deleted and replaced with --a customer-- since no customer was previously recited.

With respect to claim 14, it is suggested that the term “the business accessory” in line 4 be deleted and replaced with --each business accessory-- since a plurality of business accessories was previously recited.

With respect to claim 17, it is suggested that the term “item” in line 2 be deleted to insure consistent terminology is used throughout the claims.

Appropriate correction and/or clarification is required.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 4, 9-10, and 14-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Dennesen (US 4,803,922). Dennesen teaches a method for providing a customized decoration to an item (i.e., pens, golf balls, etc.) comprising providing a plate 42 with a formation of a predetermined decoration (see column 3, lines 63-68) in a printing machine, supporting the item in a support structure 32 and retaining a substrate on the item in a jig 84, 200, 220, transferring, by a printing element 68, 170, 234, ink from the formation to the substrate, and removing the item from the support structure.

With respect to claims 4 and 17, note Figure 33 of Dennesen teaches the jig includes a wall 221 for engaging an edge of the business accessory and a plate 200 containing an aperture 206 adapted to be placed over the business accessory so as to capture a perimeter edge (at least partially) of the substrate within the aperture.

With respect to claims 9 and 22, note Dennesen teaches the formation is an image set forth as desired by the user. See, for example, column 8, lines 37-42 and column 13, lines 51-55.

With respect to claim 10, it is noted that this is a product-by-process claim and thereby under the guidelines set forth in MPEP 2113, it is the patentability of the product claimed and not the process steps recited which must be established. Therefore, Dennesen teaches a printed business accessory (i.e., golf ball, pens, T-shirts, etc.) as recited.

With respect to claim 14, note Dennesen teaches a printing machine including an inking plate 42, an inking “pad” 80 movable into contact with the plate at predetermined times, a jig for retaining and aligning the substrate, and a printing pad 68, 170, 234, 290 as recited. Note the term “pad” is defined by Merriam Webster’s Collegiate Dictionary, 10<sup>th</sup> edition as “a piece of material saturated with ink for inking the surface of a rubber stamp”. Thus, since the brush member 80 of Dennesen is used to apply ink to the plate, it can broadly be considered to be an inking “pad” as recited.

With respect to claim 15, note Dennesen teaches the jig 84, 200 includes a well structure 96, 221 adapted to seat the substrate in the well structure.

With respect to claim 16, 18, and 19-21, to the extent that any of these claims are proper dependent claims, note the device of Dennesen is broadly capable of printing a business accessory such as a bag, case, portfolio, padfolio including a substrate attached thereto by elastic cords and therefore meets the claim language as recited. With respect to claim 21, note the printing pad 68 has a curved edge that flexes as the printing element contacts the domed face of the substrate. See, for example, Figures 3-6.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 5 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dennesen (US 4,803,922). Dennesen teaches a method as recited with the exception of the item being a portfolio or padfolio as recited. Dennesen teaches the method can be used for printing upon a variety of 2-dimensional or 3-dimensional items, such as golf ball, pens, T-shirts, sheet

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material, etc. in column 15, lines 9-13. Therefore, it would have been obvious to one of ordinary skill in the art to use the method of Dennesen to print upon any article upon which advertising, promotional, or other printed indicia is desired to be printed, such as a padfolio or portfolio, to allow low cost mass production of personalized printed items, such as to promote one's business.

With respect to claims 7-8, again note that Dennesen teaches printing upon a wide variety of objects made of different materials and furthermore, any surface can be considered to accept ink to some extent. Furthermore, the broad provision of a surface finish on a rubber or plastic object to promote ink acceptance is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art to use the method of Dennesen to print upon a substrate comprised of a soft rubberized plastic material with a surface finish adapted to accept ink in order to provide clear and personalized printing of soft plastic objects, such as pens, to promote/market one's place of business.

### ***Allowable Subject Matter***

11. Claims 2-3 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter:



With respect to claims 2-3, the prior art of record fails to teach or fairly suggest a method including all of the steps as recited, in combination with and particularly including, the step of retaining the substrate on the item in a jig including stretching elastic cords attached to the substrate so as to seat the substrate in a well structure on the jig.

With respect to claim 5, the prior art of record fails to teach or fairly suggest a method including all of the steps as recited, in combination with and particularly including, the substrate being mounted on a side pocket of the padfolio or portfolio item and placing an edge of the item against a wall of the jig includes directing a plate of the jig between a side of the item and the pocket.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Adner (US 5,806,419), Bottari et al. (US 5,151,386) and Penrice (US 5,266,142) each teach a pad printing assembly and method including a support for the object being printed having obvious similarities to the claimed subject matter.

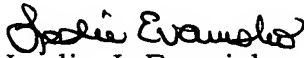
14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Leslie J. Evanisko** whose telephone

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number is **(571) 272-2161**. The examiner can normally be reached on M-Th 7:30 am-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew H. Hirshfeld can be reached on (571) 272-2168. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Leslie J. Evanisko  
Primary Examiner  
Art Unit 2854

lje  
March 4, 2005